



28 SEP 2007

Charles A. Muserlian
Hedman and Costigan
1185 Avenue of the Americas
New York, NY 10036

In re Application of	:	
TRIFONI, et al.	:	DECISION ON PETITION
Serial No.: 10/550,123	:	
PCT No.: PCT/EP04/03424	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 31 March 2004	:	
Priority Date: 01 April 2003	:	
Atty Docket No.: 267.193	:	
For: METHOD FOR OPERATING A	:	
MEMBRANE ELECTROCHEMICAL	:	
GENERATOR	:	

This decision is in response to applicant's "RENEWED RULE 47(a) PETITION" filed 29 June 2007 to accept the application without the signatures of joint inventors, Eduardo Trifoni and Matteo Lenardon.

BACKGROUND

On 22 March 2006, applicant filed a petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors Eduardo Trifoni and Matteo Lenardon. On 04 August 2006, a decision on petition was mailed to applicant indicating that all of the requirements of 37 CFR 1.47(a) were not satisfied.

On 07 September 2006, a renewed petition was filed. On 01 December 2006, a decision dismissing the petition was mailed to applicant indicating that applicant had not yet fulfilled the requirements of 37 CFR 1.47(a).

On 12 April 2007, applicant filed a renewed petition. On 21 June 2007, a decision dismissing the petition was mailed to applicant indicating that factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort was not satisfied.

On 29 June 2007, applicant filed the instant communication "Renewed Rule 47(a)

Petition” which, in effect, requests reconsideration of the evidence provided in the petitions filed on 22 March 2006, 07 September 2006 and 12 April 2007.

DISCUSSION

The decisions mailed on 4 August 2006, 01 December 2006 and 21 June 2007 are hereby incorporated by reference.

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1), (3) and (4) above were previously satisfied.

Regarding item (2) above, Petitioner contends that Eduardo Trifoni and Matteo Lenardon have refused to sign the application.

Inventor Lenardon

Petitioner continues to rely on Anna Tuosto’s letter of 21 December 2005 wherein she states “documents are necessary for the extension to USA and Canada”. Ms. Tuosto’s inquiry refers to “the document for validation abroad”. As previously stated in the prior decisions, this is insufficient to prove that a complete copy of the application, including claims, drawings, and declaration were mailed to the nonsigning inventor. Ms. Tuosto’s letter does not identify the application number of the application at issue and does not identify the enclosures that must be sent to Mr. Lenardon. The documentary evidence provided is in conflict with her declarations and does not support her statements. Thus, it cannot be concluded that Mr. Lenardon has been apprised of the application at issue and refuses to sign.

Petitioner must provide the nonsigning inventor with a complete copy of the application papers before a petition under 37 CFR 1.47(a) can be granted.

As previously stated, the English translation of the Italian postal receipt, presented as evidence of the confirmation of receipt by inventor Lenardon, does not appear to be a translation of the proof of confirmation of receipt. Rather, the translation seems to be one of another postal form which deals with acceptance of mail, a statement forbidding enclosing money, blank spaces for the receiver and sender’s information, etc. The translation does not appear to correspond to the Italian postal receipt presented as evidence of the receipt of the materials by the inventor.

Mr. Lenardon’s silence cannot be construed as a refusal in the immediate circumstances as it is unclear whether he received the papers and whether the papers did in fact contain a complete copy of the application including an oath or declaration for execution.

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in pertinent part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956)

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

(Emphasis added.)

What is required is that Petitioner resend a complete copy of the application papers to the nonsigning inventor Lenardon's last known address. Proof that a *bona fide* attempt was made is required along with a statement by one having a first hand knowledge.

Inventor Trifoni

With respect to inventor Eduardo Trifoni, Petitioner contends that the communication, referred to as an email, was sent to Mr. Trifoni and that Ms. Tuosto received "his e-mail reply to her e-mail request to executed the application indicated that he would not sign", *As previously advised*, Petitioner has failed to provide evidence that Ms. Tuosto's email message was *actually sent to and received by Mr. Trifoni*. No proof of receipt of the electronic transmission has been provided to demonstrate the non-signing inventor's refusal to sign the application papers.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the papers *for this application* (specification, claims, drawings and oath/declaration) were sent to Eduardo Trifoni and Matteo Lenardon, and *when such papers were sent*. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration. All documentary evidence should be translated into English. *See* MPEP 409.03(d) for further clarification.

Applicant has not presented sufficient evidence to show that Messrs. Lenardon and Trifoni were presented with and received a complete copy of the application papers including a declaration and that they refuse to sign the application papers. In light of the above, Item (2) above is not yet satisfied and thus, it is inappropriate to grant applicant's petition under 37 CFR 1.47(a) at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Cynthia M. Kratz
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3286
Fax: (571) 273-0459